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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,970	03/16/2004	Carl-Magnus A. Andersson	ACADIA.014C2	5078

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EXAMINER

MABRY, JOHN

ART UNIT	PAPER NUMBER
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1625

NOTIFICATION DATE	DELIVERY MODE
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07/17/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No. 10/802,970	Applicant(s) ANDERSSON ET AL.	
	Examiner John Mabry, PhD	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/24/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14, 55, 60 and 78-99 is/are pending in the application.
- 4a) Of the above claim(s) 15-49 and 66-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 55, 60 and 78-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/24/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Examiner's Response

Applicant's response on April 24, 2008 filed in response to the Office Action dated January 25, 2008 has been received and duly noted.

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending. In Non-Final Office Action dated January 25, 2008, Examiner agreed to open the definition of Ar1 and Ar2 to included phenyl (elected Group I), thiophenyl, furanyl, pyridinyl and benzo-1,3-dioxolyl. Applicant has not amended claims to elected group because the Ar1 and Ar2 are defined by the terms aryl and heteroaryl remain in the claims.

In view of this response, the status of the rejections/objections of record is as follows:

Status of the Claims

Claims 1-6, 8-14, 55, 60 and 78-99 are pending and rejected.

Claims 89-99 are new.

Claims 7, 50-54, 56-59 and 61-65 have been cancelled.

Claims 15-49 and 66-77 directed towards non-elected subject matter.

35 USC § 112 Rejection(s)

The 112-2nd rejection of claims 1-14, 53-60 and 79-88 regarding the term "substituted" have been withdrawn in view of Applicants arguments.

The 112-2nd rejection of claims 1-14, 53-60 and 79-88 regarding the term “organyl” have been overcome in view of Applicants amending the claims.

The 112-1st rejection of claims 1-14, 53-60 and 79-88 regarding the terms “esters and prodrugs” have been overcome in view of Applicants amendment.

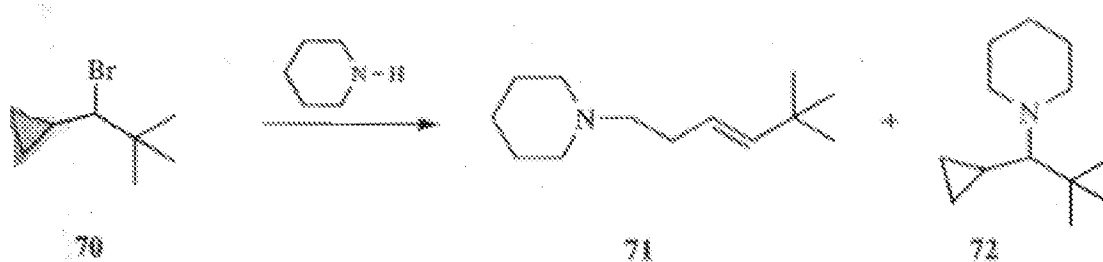
The 112-1st rejection of claims 1-14, 53-60 and 79-88 regarding the scope of enablement for “R” have not been overcome in view of Applicants amending the claims. In Non-Final rejection, the Examiner clearly communicated the chemical moieties in which Applicant is enabled.

Applicant argues three different methods as stated in the Specification that would enable one of ordinary skill to make compounds of Formula I where R is all variables claimed.

Applicant points to pages 35, 36 and 37 for methods of placing an R group on the piperdinyll ring of Formula I by alkylation with any alkylating agent, T-L1 where leaving group L1 is defined. However, Applicant does not provide in guidance/starting material for what T may be. T is not defined – see below which can be found on Specification (can not recited page number because Specification pages are not numbered).

wherein R, Q₁, Q₂, W, and T are defined in agreement with formula (I), and L₁ is a suitable leaving group.

Additionally, according to claims and Specification, the piperidiny1 portion of Formula I can be alkylated with cycloalkyl(C1-6alkyl) with an appropriate leaving group L1. March (Adv. Org. Chem., Reactions, Mechanisms and Structure, 5th Ed., page 423) discloses that when piperidine reacts with cycloalkyl(C1-6alkyl) of compound 70 below, the direct replacement of the Br- leaving group yields an 8% of the (the desired product (72) and the major product (undesired product) produced an 87% yield of compound 71. This is just one example that clearly demonstrates that Applicant's invention is not enabled for its entire claimed scope.



Claim Rejections - 35 USC § 102

Applicant's arguments with respect to 102(b) rejections have been fully considered and are persuasive on the basis that Applicant expressly defined amino as "NH₂" which cannot be substituted. The 102(b) rejection of claims 1-14, 53-60 and 79-88 regarding obviousness over US 5,216,165 (Mobilo) have been withdrawn.

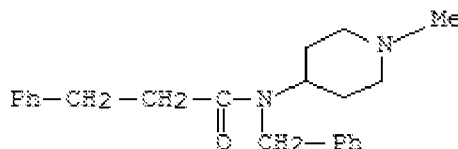
35 USC § 103(a) Rejection(s)

Applicant's arguments with respect to 103(a) rejections have been fully considered and are not persuasive over Thomas et al (Tet. Lett. 1997, 38, 5099-5102).

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Thomas discloses compounds of formula I wherein $W=O$, $Y_1=CH_2$, $Y_2=CH_2$, $R=CH_3$, $X_1=a$ bond, $X_2=CH_2$, $Ar_1=C_6H_5$ and $Ar_2=C_6H_5$ (see Table 3).

Thomas differs from the instant invention in that Thomas discloses unsubstituted phenyl which differs from the instant claims at the Ar_2 group: Thomas' H group versus the Applicant's $-CH_3$ group. A hydrogen (H) and methyl ($-CH_3$) are deemed obvious variants (*In re Wood*, 199 USPQ 137). *In re Wood*, 199 USPQ 137 provides the motivation that Applicant argued that initial rejection lacked. Thus, all compound/composition claims of instant invention remained rejected.



Obviousness-Type Double Patenting Rejection(s)

The obviousness-type double patenting rejections have not been overcome over US Patents 6,756,393 (10/409,782), 7,253,186 (10/601,070), 6,815,458 (09/800,096) and US Applications 2006/0194778 (11/417,790), 2006/0205722 (11/418,353), 2006/0199818 (11/417,866) and 2006/0094758 (11/299,566). A properly executed Terminal Disclaimer is required to overcome rejection.

Please disregard obvious double patenting rejection over US 2006/0100660 A1 which was due to a typographical error.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Applicant is respectfully reminded that it is required that all claims be amended to elected group. Examiner also warns Applicant not to introduce new matter when amending.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's primary examiner can be reached at (571) 272-0684, first, or the Examiner's supervisor, Janet Andres, PhD, can be reached at (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/John Mabry/
Examiner
Art Unit 1625

/Rita J. Desai/
Primary Examiner, Art Unit 1625